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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,856	11/24/2003	Timothy Roberts	920476-95165	5181
23644 7590 06/09/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
AKINTOLA, OLABODE				
ART UNIT		PAPER NUMBER		
3691				
NOTIFICATION DATE		DELIVERY MODE		
06/09/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary**Application No.**

10/720,856

Applicant(s)

ROBERTS, TIMOTHY

Examiner

OLABODE AKINTOLA

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/02/2009 has been entered.

Status of Claims

Claims 1 to 20 are pending, of which claims 1,8,11 and 17 are in independent form.

Declaration Under 37 C.F.R. §1.131

The Declaration filed on 3/2/2009 under 37 CFR 1.131 is sufficient to overcome the Nauer reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard

to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claims 1-16, Examiner asserts that Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is in an improper form. It is not clear the exact method steps of claim 15 that is performed by the software. Examiner suggests Applicant re-write the claim with the limitations of the method steps as recited in the method claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (USPN 5819092), hereinafter Ferguson.

Re claims 1, 11 and 17: Ferguson teaches a method of billing a communication network user for the purchase of goods or services associated with the transport of packet from the communication network into a packet communication network, each packet having an address which identifies a provider of goods or services, wherein the method comprises; providing a set of rules, and determining from said rules and each packet address, a respective billing tariff and a network user account to be debited for the transport of that packet; obtaining a coupon from an account database, representing an amount of credit, and debiting a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user (see for example, the abstract, column 8, lines 55 through col. 9, line 20 and column 29, lines 35 et seq.). Ferguson does not explicitly teach that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of guaranteeing that service provider receives payment before providing such goods or services.

Re claim 2: Ferguson teaches wherein account details for network users and account details of providers of goods and services are stored in a common accounts database (column 8, lines 55 through col. 9, line 20).

Re claim 3: Ferguson teaches wherein transfers of credit between accounts stored in the accounts database are determined from coupons generated for each transaction (column 8, lines 55 through col. 9, line 20 and column 29, lines 35 et seq.)

Re claims 4, 5, 12, 13, 18 and 19: Ferguson does not explicitly teach wherein network users have prepaid and postpaid accounts; wherein each user account is accorded a respective credit limit. Official notice is hereby taken that the concept of using a prepaid or postpaid accounts for transaction wherein the user account is accorded a credit limit is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of providing alternative forms of payment to the user, thereby enhancing the flexibility of the system.

Re claim 6: Ferguson teaches wherein user validation is performed prior to completion of a transaction (abstract, col. 3, lines 62-65, col. 10, lines 1-10).

Re claims 7, 15, 16 and 20: Ferguson does not explicitly teach wherein the network is a wireless network. Official notice s hereby taken that the use of wireless network is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of providing wireless alternative to the user, thereby enhancing the flexibility of the system.

Re claim 8: Ferguson teaches a method of on line shopping in which the cost of goods or services purchased by a customer are debited to that customer's account with a network operator and a corresponding credit is applied to an account held by a provider of those goods or services and the method further comprises obtaining a coupon from an account database, representing an amount of credit, and debiting a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user (see for example, the abstract, column 8, lines 55 through col. 9, line 20 and column 29, lines 35 et seq.).

Ferguson does not explicitly teach prepaid or postpaid account; and that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the use of prepaid or postpaid account and concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include these features for the obvious reason of providing alternative forms of payment to the user and guaranteeing that service provider receives payment before providing such goods or services.

Re claim 9: Ferguson teaches wherein a transaction charge is retained by the network operator (see for example, the abstract, column 8, lines 55 through col. 9, line 20 and column 29, lines 35 et seq.).

Re claims 10 and 14: Ferguson teaches wherein a supplier of goods and services is credited with a portion of the network operator's revenue for the transport of the packet traffic relating to a

transaction (see for example, the abstract, column 8, lines 55 through col. 9, line 20 and column 29, lines 35 et seq.).

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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